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erox Docket No. D/98003  
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K. K. K.

**PATENT APPLICATION**

**RESPONSE UNDER 37 CFR §1.116  
EXPEDITED PROCEDURE  
TECHNOLOGY CENTER ART UNIT 2673**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

David GOLDBERG et al.

Group Art Unit: 2673

Application No.: 09/682,333

Examiner: L. Lao

Filed: August 21, 2001

Docket No.: 105864

For: MANIPULATIVE USER INTERFACE SYSTEMS AND METHODS

**REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION UNDER  
37 CFR §1.116**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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MAR 03 2004

Technology Center 2600

Sir:

In reply to the January 2, 2004 final Office Action, the February 6, 2003 Advisory Action, the February 18 telephone interview and the February 19 Interview Summary, please consider the following remarks.

Applicants thank the Examiner for the courtesies shown to Applicants' representative, Klifton L. Kime, during the February 18 telephone interview. During the telephone interview, Applicants requested further clarification of the Examiner's position in view of the comments provided in the Advisory Action. Applicants' separate record of the substance of the telephone interview is incorporated into the following remarks.

Claims 1-11 are pending.

The final Office Action rejects claims 1-3 and 5-7 under 35 USC §102(b) as anticipated by U.S. Patent No. 5,841,868 to Helbig, Sr. This rejection is respectfully traversed.

As discussed during the telephone interview, Helbig, Sr. fails to disclose, teach or suggest several positively recited features of claims 1-3 and 5-7.

In particular, claim 1 recites *inter alia* "storing information about the user in a physically manipulatable device," claim 3 recites *inter alia* "storing information about the user in a physically manipulatable reified device," and claims 5 and 7 recite *inter alia* "at least one physically manipulatable element to store information about the user." As discussed during the telephone interview, Helbig, Sr. does not disclose these claimed features.

The Office Action alleges that "storing (220) information about the user in a physically manipulatable reified device (14,30)" is disclosed in Helbig, Sr. However, neither the keyboard 14 nor the reader 30 store information about the user. Applicants reasserted this during the telephone interview and the Examiner agreed to withdraw the rejection over Helbig, Sr. Applicants gratefully acknowledge that the agreement to withdraw the rejection is reflected in the Interview Summary.

The Office Action rejects claims 1-3 and 5-7 under 35 USC §102(e) as anticipated by U.S. Patent No. 6,137,480 to Shintani. This rejection is respectfully traversed.

As discussed during the telephone interview, Shintani fails to disclose, teach or suggest several positively recited features of claims 1-3 and 5-7.

As noted above, claim 1 recites *inter alia* "storing information about the user in a physically manipulatable device," claim 3 recites *inter alia* "storing information about the user in a physically manipulatable reified device," and claims 5 and 7 recite *inter alia* "at least

one physically manipulatable element to store information about the user." As discussed during the telephone interview, Shintani does not disclose these claimed features.

During the telephone interview, the Examiner clarified her position from that stated in the final Office Action. In particular, the Examiner explained that, in Shintani, the keyboard 3 is considered to be part of the computer 1 which is considered to store an ID/code to compare with the user information from the non-contact card 2. As this basis for rejecting the claims over Shintani is not stated in the final Office Action, withdrawal of the finality of the Office Action is respectfully requested. As discussed during the telephone interview, the citation of figures 1-3, column 2, lines 24-68 and column 3, lines 1-48 is insufficient to provide Applicants with a clear and proper basis for the rejection.

The Examiner's position as clarified during the telephone interview is not evident from the rejection as stated in the final Office Action, page 3, paragraph 4. In fact, the rejection as stated in the final Office Action contradicts the Examiner's clarified position by only referring to the keyboard 3 as allegedly being "a physically manipulatable reified device." The final Office Action clearly identifies the computer 1 and display 4 as allegedly being "a responsive device." It is respectfully submitted that Applicants could not have possibly derived the Examiner's position without any indication that the keyboard 3 and the computer 1 are being considered to be "a physically manipulatable reified device."

In other words, as explicitly stated by the final Office Action, the keyboard 3 is alleged to be a manipulatable device and the combination of the computer 1 and the display 4 are alleged to be a responsive device. Thus, the final Office Action clearly refers to two separate devices: (1) the keyboard; and (2) the computer/display. This is inconsistent with the Examiner's clarified position that the keyboard 3 and the computer 1 are considered to be the manipulatable device.

Further, the rejection explicitly alleges that "manipulating the object communicates at least some of stored information about the user (authorization user) to the responsive device" (emphasis added). According to the Examiner's clarified position, the user information is stored in the computer 1. This is inconsistent with the stored user information being communicated to "responsive device," i.e., the computer 1 and the display 4 as stated in the rejection.

The Interview Summary sets forth yet another position that differs from both the position stated in the final Office Action and the Examiner's position as clarified during the telephone interview. The Interview Summary states that "Shintani teaches a method for storing personal identification information transmitted from the card (2) in [a] physically manipulatable device," citing column 3, lines 4-10 of Shintani.

Therefore, Applicants respectfully submit that the outstanding rejection should be withdrawn. Should the Examiner wish to maintain her position as clarified during the telephone interview or as stated in the Interview Summary, such a position should be properly set forth in a new rejection because such a position is a new ground of rejection.

However, Applicants respectfully request that the outstanding rejection be withdrawn and the claims be allowed in view of the following remarks.

Assuming *arguendo* that Shintani is interpreted such that the keyboard 3 and the computer 1 are alleged to be "a physically manipulatable device," that only the display 4 is alleged to be "a responsive device," and that the non-contact card 2 is alleged to be "an object" as recited in claim 1, it is respectfully submitted that the features recited in claim 1 are not anticipated or rendered obvious by Shintani.

Claim 1 recites a method of transferring information about a user of a responsive object/device to that responsive object/device. As recited, information about the user is

stored in a physically manipulatable device. When an object is placed relative to the physically manipulatable device or when object is physically manipulated, at least some of the stored information about the user is communicated to the responsive device.

Assuming *arguendo* that the "physically manipulatable device" (computer 1 and keyboard 3) stores information about a user, the "stored information about the user" is the user table stored on a storage medium such as a hard disk and memory of the body of the computer, as described in column 2, line 66 - column 3, line 3. When the "object" (non-contact card 2) is placed relative to the "physically manipulatable device" (computer 1 and keyboard 3), "personal identification information stored in the non-contact card 2 is transmitted to the communication section 14, is supplied to the body of the computer . . . and the body of the computer authenticates a user." (Col. 2, lns. 62-66, emphasis added.)

However, there is no disclosure that any of the "stored information" - the information about a user stored in the user manipulatable device, i.e., the user table stored by the computer body - is transmitted or communicated, let alone transmitted or communicated to the "responsive device" (display 4). Therefore, even in view of the Examiner's position as clarified during the telephone interview and as stated in the Interview Summary, claim 1 is not anticipated or rendered obvious by Shintani.

It is respectfully submitted that the foregoing arguments equally apply to independent claims 3, 5 and 7. Accordingly, withdrawal of the rejection and allowance of claims 1-3 and 5-7 is respectfully requested in view of the arguments submitted in the January 16, 2004 Request for Reconsideration and the arguments set forth above.

The final Office Action rejects claims 4 and 8-10 under 35 USC 103(a) as unpatentable over Helbig, Sr. or Shintani in view of U.S. Patent 5,845,265 to Woolston. This rejection is respectfully traversed.

In view of the agreement to withdraw the §102 rejection over Helbig, Sr., withdrawal of this rejection, at least the portion based in part on Helbig, Sr., should be withdrawn.

With respect to the portion of this rejection based on Shintani in view of Woolston, it is respectfully submitted that Woolston fails to make up for the deficiencies of Shintani as discussed above and in the January 16, 2004 Request for Reconsideration. Therefore, it is respectfully submitted that claims 4 and 8-10 are patentable over the asserted combination of references at least in view of the patentability of claims 3 and 7 from which they respectively depend, as well as for the additional features they recite.

Accordingly, withdrawal of the rejection of claims 4 and 8-10 is respectfully requested.

The Office Action rejects claim 11 under 35 USC §103(a) as unpatentable over Shintani in view of U.S. patent 6,257,984 to Gershon. This rejection is respectfully traversed.

It is respectfully submitted that Gershon fails to make up for the deficiencies of Shintani as discussed above and in the January 16, 2004 Request for Reconsideration. Therefore, it is respectfully submitted that claim 11 is patentable over the asserted combination of references at least in view of the patentability of claim 1 from which it depends, as well as for the additional features it recites.

Accordingly, withdrawal of the rejection of claim 11 is respectfully requested. In view of the foregoing, Applicants respectfully submit that claims 1-11 are patentable over the applied art and should be allowed. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further is desirable to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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Date: March 1, 2004

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